

### **REMARKS**

The final Office Action mailed on April 9, 2008 ("Office Action") has been received and carefully considered. Applicants respectfully traverse certain positions taken by the Office as set forth in detail below.

#### **I. The IDS Must Be Considered**

With respect to the information disclosure statement filed December 17, 2007 ("IDS"), the Office Action states that the "IDS has been placed in the application file, but the information referred to therein has not been considered as to the merits." See Office Action, page 2. The Office's failure to consider any part of the IDS is contrary to law and Office policy. Specifically, the Office provides four reasons for its failure to consider the IDS. As detailed below, none of these reasons justify the Office's complete failure to consider any of the documents cited therein.

First, the Office states that "[m]any of the references do not have relevant dates that are prior to the filing date of the application, let alone the priority date." See Office Action, page 2. This observation does not justify ignoring every reference cited in the IDS. As stated in the MPEP, "[t]here is *no requirement* that the information [submitted in an IDS] must be prior art references in order to be considered by the examiner." MPEP § 609 (emphasis added). Accordingly, that certain citations do not qualify as prior art is not a sound basis for refusing to consider the IDS.

Second, the Office states that "[m]any of the NPL references are missing dates altogether." See Office Action, page 2. Again, this observation does not justify a flat refusal to consider any of the references cited in the IDS. As is made clear in the MPEP, if a reference does not comply with 37 C.F.R. § 1.98, the Office may refuse consideration of that reference only.

If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 ***will be considered*** by the examiner.

MPEP § 609.05(a) (emphasis added). Accordingly, the Office is not entitled to ignore the entire IDS due to a failure of some of the references to include date information.

Third, the Office states that certain cited references “don’t appear to have much relevance to the current application.” Applicants assert that whether particular references do not, in the Office’s judgment, appear to be relevant, is not a sound basis for a complete failure to consider any reference in the IDS.

Finally, the Office states that the IDS “has 280 items.” Applicants assert that the number of items in an IDS does not justify an outright refusal to consider any reference cited in the IDS. Applicants further note that a review of the image file wrapper in the present case as it appears in the PAIR system reveals that the examiner has searched class 705, subclasses 35, 36 and 37. Based on a search via the Office’s web site, there are over two thousand documents in such subclasses.

In sum none of the Office’s statements provide a valid basis for refusing to consider the IDS *in toto*. Applicants therefore request that the Office consider each reference in the IDS according to the procedures set forth in the MPEP.

## **II. The Requirement For Information Is Improper And Must Be Withdrawn**

The Office’s entire requirement (“Requirement”) for information under 37 C.F.R. § 1.105 reads, in its entirety, as follows:

As a result of the problems with the IDS, Rule 37 CFR 1.105(a)(1)(iii) requirement will be imposed to provide the relevance of each reference in the 12/17/07 IDS.

Office Action, page 2. Applicants assert that the Requirement is overbroad and must be withdrawn.

As a threshold matter, Applicants note that 37 C.F.R. § 105(a)(1)(iii) is directed to documents. Specifically, under that section, the Office may require a “copy of any non-patent literature,

published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.” See 37 C.F.R. § 105(a)(1)(iii). Thus, a demand to “provide the relevance of each reference” cannot be made under this section.

Moreover, the Requirement is overbroad and contrary to the procedures set forth in the MPEP. For example:

- “A requirement for information under 37 CFR 1.105 should be narrowly specified and limited in scope.” MPEP § 704.14.
- “The requirement must clearly indicate that a requirement under 37 CFR 1.105 is being made, the basis for the requirement, and what information is being required.” MPEP 704.14(a).
- “The requirement should state why the requirement has been made and how the information is necessary to the examination.” MPEP 704.14(a).
- “The criteria for measuring the scope of a 37 CFR 1.105 requirement is the plain meaning of the text of the requirement. For this reason, it is essential that the scope of information required be carefully specified.” MPEP 704.14(b).

Applicants submit that the Requirement fails to meet any of these criteria. The Requirement is extremely broad, rather than “narrowly tailored.” The Requirement fails to “clearly indicate” a sound “basis for the requirement,” at least because the Office’s position with respect to the IDS is improper. See Section I, *supra*. The Requirement fails to state “how the information is necessary to the examination.” Further, the “scope of the information required” is set forth in a blunderbuss fashion, rather than being “carefully specified.” Accordingly, the Requirement is overbroad and must be withdrawn.

Finally, Applicants note that the Office removed the requirement of providing a concise statement of relevance of each reference submitted in an information disclosure statement back in 1992. See 57 Fed. Reg. 2021 *et. seq.* In doing so, the Office specifically stated as follows:

In response to the comments [received as part of the notice and comment rulemaking procedure], § 1.98(a)(3) has been modified to require a concise explanation *only* of patents, publications or other information listed in an information disclosure statement that are *not in the English language*. Applicants *may, if they wish*, provide concise explanations of why English-language information is being submitted and how it is understood to be relevant.

57 Fed. Reg. 2030-31 (emphasis added). Applicants do not believe that 37 C.F.R. § 1.105 somehow reinstated the statement-of-relevance requirement of 37 C.F.R. § 1.98 *sub silencio*. That is, Applicants assert that the Office is improperly attempting to shoehorn, via 37 C.F.R. § 1.105, a requirement under former 37 C.F.R. § 1.98 that the Office disavowed over a decade ago. Accordingly, the Requirement is improper under the law and Office policy and must be withdrawn.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

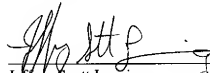
In the event that the U.S. Patent and Trademark Office requires any fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: May 8, 2008

By:

  
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Jeffrey Scott Leaning  
Registration No. 51,184

Hunton & Williams LLP  
Intellectual Property Department  
1900 K Street, N.W., Suite 1200  
Washington, DC 20006-1109  
(202) 419-2092 (telephone)  
(202) 778-2201 (facsimile)  
JSL:mia